



29 AUG 2003

Peter C. Lauro  
Lahive & Cockfield  
28 State Street  
Boston, MA 02109

In re Application of :  
CAPRATHE et al. :  
Application No.: 09/674,812 : DECISION ON PETITION  
PCT No.: PCT/US99/09463 :  
Int. Filing Date: 30 April 1999 :  
Priority Date: 05 May 1998 :  
Attorney Docket No.: BBI-5060CPUS :  
For: SUCCINAMIDE INHIBITORS OF  
INERLEUKIN-1B CONVERTING  
ENZYME

This is a decision on applicants' "Request for Reconsideration of Renewed Petition to Revive an Abandoned Application Pursuant to 37 CFR 1.137(b)" filed in the Patent and Trademark Office (PTO) on 18 August 2003.

### BACKGROUND

On 30 April 1999, applicants filed international application no. PCT/US99/09463 which claimed a priority date of 05 May 1998. A Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 06 November 2000 (05 November 2000 was a Sunday).

On 06 November 2000, applicants filed a Transmittal Letter for entry into the national stage accompanied, *inter alia*, by: the requisite basic national fee and a copy of the international application.

On 19 December 2000, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) along with a surcharge for providing the oath or declaration later than 30 months from the priority date was required. The notification set a one (1) month period for response. The notification was mailed to the attorney of record listed on the 06 November 2000 Transmittal Letter.

On 04 September 2001, applicants filed: Status Inquiry Letter; Notification of Change of Mailing; Notification of Change of Attorney Docket Number; copy of Revocation of

Prior Powers of Attorney and Appointment of New Power of Attorney; and a Return Postcard card.

On 11 September 2001, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 19 December 2000 within the time period set therein. The Notification of Abandonment was mailed to the attorney of record listed on the 06 November 2000 Transmittal Letter.

On 21 December 2001, applicants filed "Request for Withdrawal of Notification of Abandonment" which was treated as a petition under 37 CFR 1.181. Applicants petition was dismissed without prejudice in a decision dated 08 February 2002.

On 21 May 2002, applicants filed "Petition to Revive an Abandoned Application Pursuant to 37 CFR 1.137(b)." The petition was dismissed in a decision dated 08 July 2002 because the declaration was defective pursuant to 37 CFR 1.497.

On 08 November 2002, applicants filed renewed petition under 37 CFR 1.137(b). The petition was dismissed in a decision dated 19 March 2003 because the declaration was defective pursuant to 37 CFR 1.497.

On 18 August 2003, applicants "Request for Reconsideration of Renewed Petition to Revive an Abandoned Application" and "Petition to Change Inventor's Name under 37 CFR 1.182."

### DISCUSSION

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c). Applicants have satisfied Items (2)-(4).

In order to comply with the proper response requirement of item (1) above for revival under 37 CFR 1.137(b), applicants submitted the present Petition Under 37 CFR 1.182. Under the present circumstances, in order for the response requirement, item (1) above, to be satisfied, the petition to change inventor's name under 37 CFR 1.182 must be grantable.

The Manual of Patent Examining Procedure at § 605.04(c) requires in instances where an inventor has changed his or her name after the application has been filed to submit a petition under 37 CFR 1.182. The petition must include the appropriate petition fee and an affidavit signed with both names setting forth the procedure whereby the change of name was effected, or certified copy of the court order. The petition fee will be charged to Deposit Account no. 12-0080.

The petition under 37 CFR 1.182 has been reviewed and is approved. The declaration submitted on 08 November 2002 is accepted.

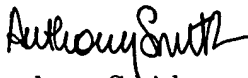
Therefore, applicants have satisfied all requirements under 37 CFR 1.137(b).

**CONCLUSION**

All of the requirements of 37 CFR 1.137(b) have been met and applicant's petition to revive is **GRANTED**.

The application has an international filing date of 30 April 1999 under 35 U.S.C. 363 and a 35 U.S.C. 371(c) date of **08 November 2002**.

This application is being returned to the United States/Elected Office for processing in accordance with this decision.



Anthony Smith  
Attorney-Advisor  
Office of PCT Legal Administration  
Tel.: 703-308-6314  
Facsimile: 703-308-6459